

Advisory Action Attachment

112 FIRST PARAGRAPH

In order to facilitate discussion of the 112 first paragraph rejection, the following illustration is provided:

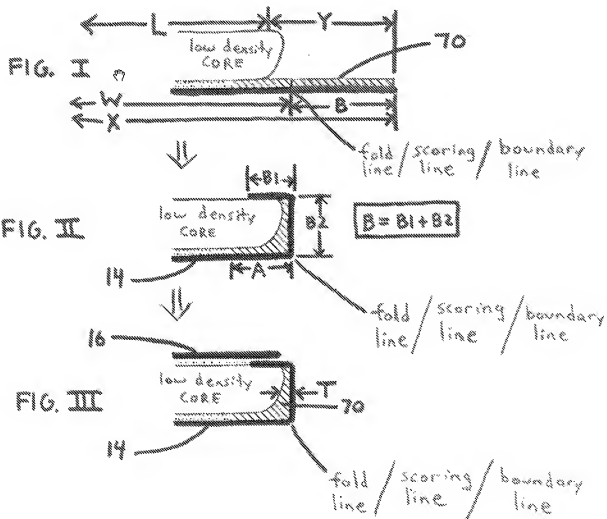


Figure I, Figure II and Figure III (as presented above) were prepared by examiner using applicant's illustration of the L-SHAPE in Figure 5. The illustration shows three steps - (1) before folding of face paper 14 (Figure I), (2) after folding of face paper 14 (Figure II) and (3) after application of back paper 16 (Figure III). The reference characters have the following meaning:

Y = length of non-spread portion
L = length of spreading roll 22
W = width of board
 = width between fold lines
 = width between scoring lines
 = width between boundary lines
B = width of face paper between fold line and edge of face paper
B1 = width of face paper on back of core
B2 = width of face paper in thickness direction
A = length of high density slurry between fold line and boundary between dotted cross section and lined cross section
T = length of hard edge part at middle position between front side and back side
14 = face paper
16 = back paper
70 = high density slurry

In above Figure I, the high density slurry 70 was drawn by examiner as extending to the edge of the paper because Figure 2 of applicant's disclosure appears to illustrate the high density slurry as extending to the edge of the face paper 14. The boundary line between distance L (length of spreading roller 22) and distance Y (length of the non-spread portion) is indicated as being inside of the fold line / scoring line because Figure 2 appears to illustrate the spreading roller as having a length less than the distance between the fold lines defined by folding shoes 61.

Applicant argues and examiner agrees that the width of the non-spread portion is different from the width of the board. As can be seen from above Figure 1, **width W of the board** is greater than **width Y of the non-spread portion**.

Applicant argues and examiner agrees that the slurry for the non-spread portion may flow. As can be seen from a comparison of above Figure I and above Figure II, the high density slurry 70 for the non spread portion flows to form the hard edge part when the face paper 14 is folded.

Applicant argues that the length of the hard edge part may be more than the width of the non-spread portion. Examiner disagrees. From a cursory inspection of above Figure I and above Figure III, it can be seen that **length T of the hard edge part** is less than **width Y of the non-spread portion**. Examiner asserts that the *folding of the face paper and the flow of the high density slurry prevent length T of the hard edge part from being longer than width Y of the non-spread portion*. Thus, examiner maintains that the combination of the range of 0.1 mm to 15 mm for the length of the hard edge part (the broad disclosure) and the range of less than 10 mm for the width of the non-spread part (the preferred disclosure) is not supported by the original disclosure (i.e. the combination of these ranges is new matter). Claim 1 reads on the length (15 mm) of the hard edge part being greater than the width (less than 10 mm) of the non-spread part, and applicant failed to have possession of this subject matter at the time of filing of the original disclosure.

Applicant argues that it is possible for one skilled in the art to attain a feature of a length of a hard edge part being "0.01 mm to about 15 mm" and a width of the non-

spread portion being "less than 10 mm". This argument is not persuasive. FIRST: The relevant standard for showing possession of the claimed invention is "reasonably convey" instead of "it is possible". SECOND: It is not possible for length T of the hard edge part to be more than width Y of the non-spread portion because the length of the hard edge part is limited by the folding of the front paper.

The 35 USC 112 first paragraph rejection of claims 5-13 and 15 stands.

103 REJECTION

With respect to claims 5-13, applicant's arguments are not persuasive for the reasons given in the last office action dated 7-9-09. However, the prior art rejection of claim 15 has been withdrawn. It is noted that claims 14 and 16 are canceled claims.

ALLOWABLE SUBJECT MATTER

In order to place this application in condition for allowance, the following changes are suggested:

- (1) in claim 5 line 33 change "98% through 108%" to
--greater than 100% and 108% or less--;
- (2) in claim 5 line 38 delete --, and--
- (3) in claim 5 delete lines 39-42 (last four lines) except for the period;
- (4) cancel claims 1-4 (non-elected claims), 13 and 15;
- (5) in Figure 2, change "61" to --161--;
- (6) on page 35 line 10 of the specification, change "61" to --161--;
- (7) on page 35 line 14 of the specification, change "61" to --161--.

If an after final amendment is filed which includes the above changes and does not make additional changes raising new issues, then such an after final amendment would be entered. The proposed amendment to the drawings and specification corrects a minor informality; the reference character "61" is used for a delivery pipe in Figure 1 and Figure 3.

Upon careful reconsideration, the prior art including Japan 808 (JP 08-112808) and Phillips et al (US 5,718,797) whether taken individually or in combination fails to render obvious the width of the non-spread portion being less than 10 mm and the length of the spreader roll being greater than 100% and 108% or less in combination with the remaining limitations of claim 5. With respect to the USPTO translation of Japan 808 supplied with the last office action, Japan 808 fails to teach or render obvious using a spreader roll having a length greater than the width of the board (the distance between boundary lines of the front and the side surface) because (1) Japan 808, which fails to teach forming the hard edge part with a small width so that a nail can be driven through the board without penetrating the hard edge part, teaches forming a damming part from the non-spread part by folding both edges of the bottom paper upward (page 12 of translation) and (2) Japan 808 teaches that the slurry is forced out from both ends of coating roll 14 ("spreader roll") into edge parts of base paper A where both ends are folded (page 16 of translation). These teachings reveal that the folding line for the base paper A should not be under the coating roller 14 ("spreader roll"). Phillips et al (col. 2 lines 63-65, col. 4 lines 15-18, col. 5 lines 12-13) discloses a "spreading roll" having a length of 94% of the width of the board (45 inches / 48 inches x

100%), but fails to teach or render obvious a spreading roll having a length of greater than 100% of the width of the board.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven D. Maki/
Primary Examiner, Art Unit 1791

Steven D. Maki
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